

## **REMARKS**

Claims 1-6, 8-17, 38-41 and 51-52 are pending, and claims 7, 18-37, 41-50 and 53 have been cancelled without prejudice. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments contained herein.

### **REJECTION UNDER 35 U.S.C. § 102**

Claims 1-6, 8-9, 11-12, 17, 38-40 and 52 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Viswanathan (U.S. Pub. No. 20040068173). This rejection is respectfully traversed.

#### **Independent Claim 1**

The Applicants submits that Viswanathan ('173) does not anticipate the claimed feature of a memory or electronic identification device on the elongate medical device, which includes information on the physical and geometric properties of the elongate medical device. With regard to this claimed feature, the Office Action makes numerous references to ¶ [0042], [0047-0048] and [0094] in Viswanathan ('173).

However, ¶ [0042] in Viswanathan discloses calculations that take into account properties of a device that are in a look up table of the system. The disclosure of a look-up table of several device types stored on a system does not anticipate or teach a device having a memory on the device that stores information about the specific device.

In ¶ [0047-0048], Viswanathan ('173) states that "The system can store the properties of various types of medical devices, and one of these stored values could be used in the mathematical model." The disclosure of properties of various types of medical devices stored on a system does not anticipate or teach a device having a memory on the device that stores information about the specific device.

In ¶ [0094], Viswanathan ('173) states that "the medical device can be selected from a menu of medical devices whose stiffness value is pre-programmed into the system." The disclosure of stiffness values for various types of medical devices pre-programmed on a system does not anticipate or teach a device having a memory on the device that stores information about the specific device.

In each of the above paragraphs, Viswanathan ('173) discloses pre-programming or storing a look-up table or other information in the system. Thus, the system must be pre-programmed to include specific information on a variety of medical devices, which would not accommodate any newer medical devices that are made after the system had the specific information stored or pre-programmed into the system. Thus, the above disclosed system that only looks up information relating to only those medical devices stored on the system would not be capable of working with a newer medical device having a memory with information stored thereon that is specific to the newer medical device.

The Office Action states on page 4 that (based on ¶ [0042], [0047-0048], [0094]) Viswanathan ('173) discloses the claimed device including information on the physical and geometric properties on the elongate medical device. This is clearly not the case, given that the Applicants have shown that Viswanathan ('173) only discloses properties of various types of medical devices stored on a system. Thus, contrary to claim 1, Viswanathan ('173) does not anticipate or teach a medical navigation system having an elongate medical device with an electronic identification device on the elongate medical device that includes information on the physical and geometric properties of the device. As such, the Applicants submit that claim 1 is not anticipated by Viswanathan ('173).

#### Claims 2-5 and 8-9

The Office Action further states on page 5 (lines 4-11) that Viswanathan ('173) discloses an electronic identification or memory on a medical device that includes information about the specific medical device.

However, the disclosure in Viswanathan ('173) of various types of medical devices pre-programmed or stored on a system is not the same as a medical device having information stored thereon that includes physical and geometric properties of the elongate medical device. Moreover, Viswanathan ('173) does not make any disclosure of an elongate medical device that includes a memory or electronic identification having stored information that includes physical and geometric properties. As Viswanathan ('173) does not disclose an elongate medical device with an electronic identification device on the elongate medical device that includes information on the physical and geometric properties of the device, the Applicants submit that claims 2-5 and 8-9 are not anticipated by Viswanathan ('173), and are allowable for at least these reasons.

#### Claims 6, 11-12 and 17

With regard to claims 6, 11-12 and 17, these claims ultimately depend from claim 1, which Applicants believe to be allowable in view of the above remarks. As such, the Applicants submit that claims 6, 11-12 and 17 are also allowable for at least these reasons.

### Independent Claim 38

The Applicants submit that Viswanathan ('173) does not anticipate the claimed feature of a memory or electronic identification device on the elongate medical device, which includes information on the physical and geometric properties of the elongate medical device. With regard to this claimed feature, the Office Action makes numerous references to ¶ [0042], [0047-0048] and [0094] in Viswanathan ('173).

However, ¶ [0042] in Viswanathan discloses calculations that take into account properties of a device that are in a look up table of the system. The disclosure of a look-up table of several device types stored on a system does not anticipate or teach a device having a memory on the device that stores information about the specific device.

In ¶ [0047-0048], Viswanathan ('173) states that "The system can store the properties of various types of medical devices, and one of these stored values could be used in the mathematical model." The disclosure of properties of various types of medical devices stored on a system does not anticipate or teach a device having a memory on the device that stores information about the specific device.

In ¶ [0094], Viswanathan ('173) states that "the medical device can be selected from a menu of medical devices whose stiffness value is pre-programmed into the system." The disclosure of stiffness values for various types of medical devices pre-programmed on a system does not anticipate or teach a device having a memory on the device that stores information about the specific device.

In each of the above paragraphs, Viswanathan ('173) discloses pre-programming or storing a look-up table or other information in the system. Thus, the system must be pre-programmed to include specific information on a variety of medical devices, which would not accommodate any newer medical devices that are made after the system had

the specific information stored or pre-programmed into the system. Thus, the above disclosed system that only looks up information relating to only those medical devices stored on the system would not be capable of working with a newer medical device having a memory with information stored thereon that is specific to the newer medical device.

The Office Action states on page 4 that (based on ¶ [0042], [0047-0048], [0094]) Viswanathan ('173) discloses the claimed device including information on the physical and geometric properties on the elongate medical device. This is clearly not the case, given that the Applicants have shown that Viswanathan ('173) only discloses properties of various types of medical devices stored on a system. Thus, contrary to claim 38, Viswanathan ('173) does not anticipate or teach a medical navigation system having an elongate medical device with an electronic identification device on the elongate medical device that includes information on the physical and geometric properties of the device. As such, the Applicants submit that claim 38 is not anticipated by Viswanathan ('173).

#### Claims 39-40

With regard to claims 39-40, these claims ultimately depend from claim 38, which the Applicants believe to be allowable in view of the above remarks. As such, the Applicants submit that claims 39-40 are also allowable for at least these reasons.

#### Independent Claim 52

The Applicants submit that Viswanathan ('173) does not anticipate the claimed feature of a memory or electronic identification device on the elongate medical device, for the same reasons advanced above regarding claims 1 and 38. As such, the Applicants submit that claim 52 is also allowable for at least these reasons.

### **REJECTION UNDER 35 U.S.C. § 103**

Claims 13-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Viswanathan (U.S. Pub. No. 20040068173) in view of Osadchy et al. (U.S. Pat. No. 6,266,551). Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Viswanathan (U.S. Pub. No. 20040068173) in view of Burnside et al. (U.S. Pat. No. 6,237,604). These rejections are respectfully traversed.

### **Claims 10 and 13-16**

The Applicants submit that while the Viswanathan ('173) reference may be §102(e) prior art, it does not qualify for purposes of obviousness under 35 U.S.C. § 103(a) since the present application and the Viswanathan ('173) application were subject to an obligation of assignment to the same entity under § 103(c). 35 USC §103(c)(1) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The Applicants submit that the Viswanathan ('173) application is owned by Stereotaxis, Inc., by virtue of an assignment recorded at Reel 014922, Frame 0639.

The Applicants submit that the present application is owned by Stereotaxis, Inc., by virtue of an assignment recorded at Reel 014802, Frame 0204. Accordingly, the Applicants submit that the Viswanathan ( ) application and the present application are both co-owned by Stereotaxis. The Applicants also submit that at the time of the present invention, the inventor Raju Viswanathan was subject to an obligation of assignment to Stereotaxis, Inc. Thus, the Applicants submit that Viswanathan ('173) is disqualified as a reference for purposes of obviousness under 35 U.S.C. § 103(c).

The Office Action states on page 9 that the rejection under 35 U.S.C. § 103(a) might be overcome by: ... (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer.

Accordingly, the Applicants have submitted a declaration under 37 CFR 1.130 by Raju Viswanathan, stating that the present application 10/674,914 and the Viswanathan reference ('173) are currently owned by the Stereotaxis by virtue of recorded assignments, and that the inventor Raju Viswanathan named in the present application is the inventor Raju Viswanathan in the prior application under 35 U.S.C. 104. The Applicants have also submitted a Terminal Disclaimer in accordance with 37 C.F.R. 1.321(c).

As the Viswanathan ('173) application is not an appropriate reference for establishing an obviousness rejection in view of the above, the Applicants submit that claims 10 and 13-16 are not obvious and are patentable over the cited references.

#### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner

believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (314)-726-7500.

Respectfully submitted,

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